

**REMARKS**

This Amendment responds to the Office Action mailed March 3, 2009. With this amendment, Applicants amend claims 8-11. Applicants note that the Office has deemed claims 1-7 and 14-22 as being directed to non-elected subject matter and therefore withdrawn these claims from consideration. No new matter has been added with the present amendment. Support for the amendment can be found throughout the specification and claims as filed, including, e.g., in previously presented claims 1-22, and at pages 11-12 of the specification. Claims 8-13 are pending and under consideration with this amendment.

Priority

Applicants thank the Examiner for acknowledging Applicants' claim to foreign priority based on Japanese Application No. 2003-170330.

Restriction Requirement

Applicants thank the Examiner for reconsideration of the requirement for election/restriction set forth in the paper mailed December 1, 2008. Applicants thank the Examiner for including SEQ ID NOs: 2, 13, 15, 17, 19, and 21 for examination. Applicants reserve the right to file one or more divisional or continuation applications directed to the non-elected subject matter.

Drawings

Applicants also thank the Examiner for acknowledging receipt of Applicants' drawings, filed October 16, 2006, and for indicating acceptance of the same.

Information Disclosure Statement

Applicants thank the Examiner for acknowledging receipt of the Information Disclosure Statements filed on October 17, 2006, February 7, 2007, and January 9, 2008, and for returning electronically signed copies of the Forms PTO-1449 submitted therein.

Informalities

Applicants note that the Office indicated that the specification did not cite continuation data for the instant application. In response, Applicants respectfully note that this application is a National Stage application under 35 U.S.C. §371 for PCT/JP2004/08790, and there is no domestic priority claimed for this application. Thus, there is no requirement for including information in the first paragraph.

Applicants respectfully also note that the Office indicated that amino acid sequences in Figure 3 of the specification were not identified with "SEQ ID NO:" in the brief description on page 9. In response, Applicants note that in the Preliminary Amendment filed on October 16, 2006, the amendments to the specification provide SEQ ID NOs for the sequences included in the brief description on page 9.

Claim Rejections – 35 U.S.C. § 101

The Action rejects claims 8-13 under 35 U.S.C. 101 as allegedly directed to non-statutory subject matter. In response, Applicants have amended the claims as suggested by the Examiner. Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 101 in view of the amendments.

Claim Rejections – 35 U.S.C. § 112, Second Paragraph

The Action rejects claims 8-13 as allegedly being indefinite for failing to particularly point and distinctly claim the subject matter. In particular, the Action asserts that recitation of “the protein of the present invention” in claims 8, 12, and 13, and “several amino acids” or “several nucleotides” in claims 9-11, renders the claims indefinite.

In response, Applicants have amended the claims to no longer recite “the protein of the present invention,” “several amino acids,” or “several nucleotides.” Claim 8 now recites “An isolated DNA encoding a fluorescent protein having any of the following nucleotide sequences: DNA encoding the nucleotide sequence shown in SEQ ID NO: 2, 13, 15, 17, 19, or 21; or a nucleotide sequence comprising a deletion, substitution and/or addition of 1 to 60 nucleotides with respect of the nucleotide sequence shown in SEQ ID NO: 2, 13, 15, 17, 19, or 21.” Claim 9 now recites “DNA encoding an amino acid sequence comprising a deletion, substitution and/or addition of 1 to 20 amino acids with respect to the amino acid sequence shown in SEQ ID NO: 1, and encoding a fluorescent protein,” and claims 10 and 11 each recite “a nucleotide sequence comprising a deletion, substitution and/or addition of 1 to 60 nucleotides with respect of the nucleotide sequence shown in SEQ ID NO: 2, and encoding a fluorescent protein.” Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

Claim Rejections – 35 U.S.C. § 102(e)

The Action rejects claims 8-13 under 35 U.S.C. § 102(e) as allegedly anticipated by Almond et al. (U.S. Patent Application Pub. No. 2003/0157643; hereinafter “ALMOND”). In particular, the Office Action alleges that ALMOND teaches a synthetic nucleic acid molecule having 86.3% sequence identity to the DNA encoding SEQ ID NO: 1. ALMOND also allegedly

teaches a nucleotide sequence encoding a green fluorescent protein which has 81.3%, 80.8%, 79.9%, 79.9%, 81.3%, and 80.4% sequence identity to SEQ ID NOs: 13, 15, 17, 19, 2, and 21, respectively.

Applicants note that sequences comprising 1-20 amino acid or 1-60 nucleotide deletions, substitutions, or additions would encompass variants having more than 90% homology to any one of the SEQ ID NOs: 1, 2, 13, 15, 17, 19, or 21. Applicants submit that the claims do not read on ALMOND.

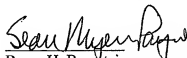
Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102(e).

### CONCLUSION

In view of the foregoing, the Office is respectfully requested to withdraw the rejections of record and allow all the pending claims.

Applicants invite the Examiner to contact the undersigned with any questions.

Respectfully Submitted,  
Atsushi Miyawaki et al.

  
Bruce H. Bernstein  
Reg. No. 29,027 42,920

June 1, 2009  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191